# UNITED STATES PATENT AND TRADEMARK OFFICE

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|---|---|---|---|
| 09/903,838 | 07/11/2001 | Richard E. Fangman | 5686-00300 | 2194 |

| | | |
|---|---|---|
| 7590     12/14/2006 | | EXAMINER |
| Jeffrey C. Hood | | LEE, ANDREW CHUNG CHEUNG |
| Meyertons, Hood, Kivlin, Kowert & Goetzel PC | | |
| P.O. Box 398 | ART UNIT | PAPER NUMBER |
| Austin, TX 78767-0398 | 2616 | |

DATE MAILED: 12/14/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

| | Application No. | Applicant(s) |
|---|---|---|
| **Office Action Summary** | 09/903,838 | FANGMAN ET AL. |
| | Examiner | Art Unit |
| | Andrew C. Lee | 2616 |

-- *The MAILING DATE of this communication appears on the cover sheet with the correspondence address* --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1)☒ Responsive to communication(s) filed on *18 September 2006*.

2a)☐ This action is **FINAL**.      2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4)☒ Claim(s) *1-8,10-23,25-38 and 40-45* is/are pending in the application.

   4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☐ Claim(s) *1-8, 10-23, 25-38, 40-45* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

**Application Papers**

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

   Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

   Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

   a)☐ All   b)☐ Some * c)☐ None of:

   1.☐ Certified copies of the priority documents have been received.

   2.☐ Certified copies of the priority documents have been received in Application No. _____.

   3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

   * See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
   Paper No(s)/Mail Date _____.

4) ☐ Interview Summary (PTO-413)
   Paper No(s)/Mail Date. _____.

5) ☐ Notice of Informal Patent Application

6) ☐ Other: _____.

## DETAILED ACTION

### *Claim Rejections - 35 USC § 101*

1. 35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1, 31 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claims 1 – 8, 10 – 15, 31 – 38, 40 – 45, are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Considering claim 31,

To determine whether the claimed subject matter complies with the is eligibility requirement of 35 USC 101, we ask

Does the claimed invention fall within an enumerated statutory category? The answer is "No".

As Evidenced at page 57, lines 17 – 21 of the specification, in "include receiving or storing instructions and /or data implemented in accordance with the foregoing description upon a carrier medium. Suitable carrier media include a memory medium as described above, as well as signals such as electrical, electromagnetic, or digital signals, conveyed via a communication medium such as networks and/or a wireless link. Thus, the claimed application in claim 31 is nothing but a software application. It is well established that a software application, i.e. computer program, per se is not physical "thing". The computer program is neither computer components nor statutory

processes. Such claimed computer program <u>does not</u> define any structural and

functional interrelationship between the computer program and the rest of the computer,

which permits the computer program's functionality to be realized.

In addition, as set forth in the Interim Guidelines page 52, for a computer

program to be statutory it must be embedded in a computer readable medium.

Thus, claim 31 is non statutory.

As to claims 1 – 8, 10 – 15, 31 – 38, 40 – 45 these claims are written in a form of

"method". However, as evidenced in claim 1, claims 1 – 8, 10 – 15, 31 – 38, 40 – 45

are claiming software in the form of method. Note that claims 1 – 8, 10 – 15, 31 – 38, 40

– 45 mirrors claim 31 in all respects except for the preamble and in light of the

specification it is nothing more than the instructions of the application.

When claim 1 falls within one of the statutory categories, we continue to ask the

following question.

Does the claimed invention cover a judicial exception? The answer is "Yes", i.e.

abstract idea- computer program.


Once the claim covers a judicial exception, we need to determine whether there

is a practical application recited in the claim. The final result achieved by claim 1 is to

provide a service protocol responsive to receiving a request identifying a value added

service protocol. It is clear that 1) there is no physical transformation recited in the

claim, and 2) no useful and tangible result recited in the claim. Thus, claims 1 – 8, 10 –

15, 31. – 38, 40 – 45 are also nonstatutory since the patent protection sought by the

claimed invention is for the computer program in the abstract.

## *Double Patenting*

2.   The nonstatutory double patenting rejection is based on a judicially created doctrine

grounded in public policy (a policy reflected in the statute) so as to prevent the

unjustified or improper timewise extension of the "right to exclude" granted by a patent

and to prevent possible harassment by multiple assignees.  See *In re Goodman*, 11

F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225

USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA

1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington*,

418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be

used to overcome an actual or provisional rejection based on a nonstatutory double

patenting ground provided the conflicting application or patent is shown to be commonly

owned with this application.  See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a

terminal disclaimer.  A terminal disclaimer signed by the assignee must fully comply with

37 CFR 3.73(b).

3.   Claims 1 – 8, 10 – 23, 25 – 38, 40 – 45 are rejected under the judicially created

doctrine of obviousness-type double patenting as being unpatentable over claims 1 – 43

of U.S. Patent No. 7068647 B2. Although the conflicting claims are not identical, they are not patentably distinct from each other because the present claims are broader versions of the patent claims.

Regarding claim 1, a comparison of present claim 1 and patent claim 1 shows that, applicant merely broadens the claim 1 of US Patent No. 7068647 B2 by eliminating the limitations of patent claim: "a Service Gateway receiving a data packet from the IP telephone, wherein the data packet comprises a private source IP address of the IP telephone, source port number, and destination information associated with an IP device; the Service Gateway performing a network address persistent port translation (NAPPT) on the data packet, including storing translation information in a data structure, wherein the translation information comprises: the private source IP address of the IP telephone; a public IP address of the Service Gateway; and the assigned ports for the IP telephone; and the Service Gateway sending the data packet to the IP device", and replacing the patent claim 1 limitation "determining if the identifier is valid" with patent claim 8 limitation "determining if a MAC ID for the IP telephone is valid; and if the MAC ID is determined to be valid, then determining if the identifier is valid" *(see U.S. Patent No. 7068647 B2, column 32, lines 35 – 42, column 33, lines 29 – 31)*.

Regarding claim 16, a comparison of present claim 16 and patent claim 15 shows that, applicant merely broadens the claim 15 of US Patent No. 7068647 B2 by eliminating the limitations of patent claim: "receive a data packet from the IP telephone, wherein the data packet comprises a private source IP address of the IP telephone, source port number, and destination information associated with an IP device; perform a

network address persistent port translation (NAPPT) on the data packet, including

storing translation information in a data structure, wherein the translation information

comprises: the private source IP address of the IP telephone; a public IP address of the

Service Gateway; and the assigned ports for the IP telephone; and the Service Gateway

sending the data packet to the IP device", and replacing the patent claim 15 limitation

"determining if the identifier is valid" with patent claim 22 limitation "determining if a

MAC ID for the IP telephone is valid; and if the MAC ID is determined to be valid, then

determining if the identifier is valid *(see U.S. Patent No. 7068647 B2, column 34, lines 9*

*– 242, column 35, lines 10 – 12)*.

Regarding claim 31, a comparison of present claim 31 and patent claim 30

shows that, applicant merely broadens the claim 30 of US Patent No. 7068647 B2 by

eliminating the limitations of patent claim: "receiving a data packet from the IP

telephone, wherein the data packet comprises a private source IP address of the IP

telephone, source port number, and destination information associated with an IP

device; performing a network address persistent port translation (NAPPT) on the data

packet, including storing translation information in a data structure, wherein the

translation information comprises: the private source IP address of the IP telephone; a

public IP address of the Service Gateway; and the assigned ports for the IP telephone;

and the Service Gateway sending the data packet to the IP device", and replacing the

patent claim 30 limitation "determining if the identifier is valid" with patent claim 37

limitation "determining if a MAC ID for the IP telephone is valid; and if the MAC ID is

determined to be valid, then determining if the identifier is valid *(see U.S. Patent No. 7068647 B2, column 35, lines 61 – 67, column 36, lines 1 – 3; lines 55 – 57).*

Regarding claim 2, applicant merely copies the limitation of claim 6 of US Patent No. 7068647 B2.

Regarding claims 4, 6, applicant merely broadens the claim 3 of US Patent No. 7068647 B2 by eliminating the limitation "wherein the data packet comprise a public destination IP address, a destination port number, and source information, wherein said public destination IP address comprises said public source IP address, and wherein said destination port number comprises said source port number", and modifies the limitation "performing a network address persistent port translation (NAPPT) on the data packet received from the IP devices; and sending the data packet received from the IP device to the IP telephone to the current claim context *(see U.S. Patent No. 7068647 B2, column 32, lines 65 – 67, column 33, lines 1 – 9).*

Regarding claim 5, applicant merely combines the claims 2 and 3 of US Patent No. 7068647 B2 by replacing the term "public destination" with "private source" in claim 3, and eliminating the limitation "performing a network address persistent port translation (NAPPT) on the data packet received from the IP device; and sending the data packet received from the IP device to the IP telephone" in claim 3.

Regarding claim 8, applicant merely copies the limitation of claim 7 of US Patent No. 7068647 B2.

Regarding claim 10, applicant merely copies the limitation of claim 9 of US Patent No. 7068647 B2.

Regarding claim 11, applicant merely copies the limitation of claim 10 of US
Patent No. 7068647 B2.

Regarding claim 12, applicant merely copies the limitation of claim 11 of US
Patent No. 7068647 B2.

Regarding claim 13, applicant merely copies the limitation of claim 12 of US
Patent No. 7068647 B2.

Regarding claim 14, applicant merely copies the limitation of claim 13 of US
Patent No. 7068647 B2.

Regarding claim 15, applicant merely copies the limitation of claim 14 of US
Patent No. 7068647 B2.

Regarding claim 17, applicant merely copies the limitation of claim 20 of US
Patent No. 7068647 B2.

Regarding claim 19, applicant merely broadens and extracts the limitation from
claim 15 of US Patent No. 7068647 B2 by eliminating "wherein the data packet
comprises a private source IP address, a source port number, and destination
information associated with an IP device; including storing translation information in a
data structure, wherein the translation information comprises: the private source IP
address of the IP telephone; a public IP address of the Service Gateway; and assigned
ports for the IP telephone".

Regarding claim 20, applicant merely combines the claims 2 and 3 of US Patent
No. 7068647 B2 by replacing the term "public destination" with "private source" in claim
3, and eliminating the limitation "performing a network address persistent port

translation (NAPPT) on the data packet received from the IP device; and sending the data packet received from the IP device to the IP telephone" in claim 3.

Regarding claim 21, applicant merely broadens and extracts the limitation from claim 15 of US Patent No. 7068647 B2 by eliminating "wherein the data packet comprises a private source IP address, a source port number, and destination information associated with an IP device; including storing translation information in a data structure, wherein the translation information comprises: the private source IP address of the IP telephone; a public IP address of the Service Gateway; and assigned ports for the IP telephone"

Regarding claim 23, applicant merely copies the limitation of claim 21 of US Patent No. 7068647 B2.

Regarding claim 25, applicant merely copies the limitation of claim 23 of US Patent No. 7068647 B2.

Regarding claim 26, applicant merely copies the limitation of claim 24 of US Patent No. 7068647 B2.

Regarding claim 27, applicant merely copies the limitation of claim 25 of US Patent No. 7068647 B2.

Regarding claim 28, applicant merely copies the limitation of claim 26 of US Patent No. 7068647 B2.

Regarding claim 29, applicant merely copies the limitation of claim 27 of US Patent No. 7068647 B2.

Regarding claim 30, applicant merely copies the limitation of claim 29 of US Patent No. 7068647 B2

Regarding claim 32, applicant merely copies the limitation of claim 35 of US Patent No. 7068647 B2

Regarding claim 34, applicant merely broadens and extracts the limitation from claim 30 of US Patent No. 7068647 B2 by eliminating "wherein the data packet comprises a private source IP address, a source port number, and destination information associated with an IP device; including storing translation information in a data structure, wherein the translation information comprises: the private source IP address of the IP telephone; a public IP address of the Service Gateway; and assigned ports for the IP telephone".

Regarding claim 35, applicant merely combines the claims 2 and 3 of US Patent No. 7068647 B2 by replacing the term "public destination" with "private source" in claim 3, and eliminating the limitation "performing a network address persistent port translation (NAPPT) on the data packet received from the IP device; and sending the data packet received from the IP device to the IP telephone" in claim 3.

Regarding claim 36, applicant merely broadens and extracts the limitation from claim 30 of US Patent No. 7068647 B2 by eliminating "wherein the data packet comprises a private source IP address, a source port number, and destination information associated with an IP device; including storing translation information in a data structure, wherein the translation information comprises: the private source IP

address of the IP telephone; a public IP address of the Service Gateway; and assigned

ports for the IP telephone".

Regarding claim 38, applicant merely copies the limitation of claim 36 of US

Patent No. 7068647 B2.

Regarding claim 40, applicant merely copies the limitation of claim 38 of US

Patent No. 7068647 B2.

Regarding claim 41, applicant merely copies the limitation of claim 40 of US

Patent No. 7068647 B2.

Regarding claim 42, applicant merely copies the limitation of claim 39 of US

Patent No. 7068647 B2.

Regarding claim 43, applicant merely copies the limitation of claim 41 of US

Patent No. 7068647 B2.

Regarding claim 44, applicant merely copies the limitation of claim 42 of US

Patent No. 7068647 B2.

Regarding claim 45, applicant merely copies the limitation of claim 43 of US

Patent No. 7068647 B2

## Claim Rejections - 35 USC § 103

4.  The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
> forth in section 102 of this title, if the differences between the subject matter sought to be patented and
> the prior art are such that the subject matter as a whole would have been obvious at the time the
> invention was made to a person having ordinary skill in the art to which said subject matter pertains.
> Patentability shall not be negatived by the manner in which the invention was made.

5.  Claims 1 – 8, 10 – 23, 25 – 38, 40 - 45 are rejected under 35 U.S.C. 103(a) as being

unpatentable over Schuster et al. (US 6822957 B1) and Fijolek et al. (US 6577642 B1)

and further in view of Lee et al. (US 6958992 B2).

Regarding claims 1, 31, Schuster et al. disclose the limitation of a method,

memory medium for configuring an IP telephone (recited "distributed network address

translation in a network telephone system" as a method, memory medium for

configuring an IP telephone; column 3, lines 18 – 32), comprising: receiving an identifier

from the IP telephone (recited "combination network address is created for the first

network phone with the at least one locally unique port and a common external network

address" as receiving an identifier from the IP telephone; column 3, lines 20 – 32;

recited "mass storage system readable by CPU" as memory medium; column 6, lines 9

– 18; column 8, lines 43 – 54; column 10, lines 23 – 32); determining if the identifier is

valid (recited ""determine the location of the callee, identified in the INVITE request" as

determining if the identifier is valid; column 8, lines 45 – 61); and if the identifier is valid,

assigning a range of port numbers to the IP telephone based on the identifier, wherein

the IP telephone is operable to use at least a subset of the range of port numbers to

send or receive IP communications (recited "request a set of locally unique ports from

router for external communications", "assigned thirty-two locally unique ports in the

range of 1026 – 1057" as operable to use at least a subset of the range of port numbers

to send or receive IP communications; column 11, lines 1 – 12; column 16, lines 13 –

20). Schuster et al. do not disclose explicitly receiving an identifier from the IP

telephone; determining if a MAC ID for the IP telephone is valid; if the MAC ID is

determined to be valid, determining if the identifier is valid. Fijolek et al. disclose the

limitation of determining if a MAC ID for the CM is valid; if the MAC ID is determined to

be valid (column 21, lines 12 – 30, 40 – 55). However, Fijolek et al. also do not disclose

explicitly receiving an identifier from the IP telephone; determining if a MAC ID for the IP

telephone is valid; if the MAC ID is determined to be valid, determining if the identifier is

valid. Lee et al. disclose the limitation of receiving an identifier from the IP telephone

(recited "IP phone then sends a request for registration to the IP phone service provider,

which includes its MAC address and set type" as an identifier from the IP telephone;

column 3, lines 16 – 32, Fig. 3, element 318, Reg Device (MAC, IP address, Set Type);

determining if a MAC ID for the IP telephone is valid (recited "upon receipt of the

validation request" as determining if a MAC ID for the IP telephone is valid; column 3,

lines 44 – 45, Fig. 3, elements 334 Validate PIN(MAC,PIN)); if the MAC ID is

determined to be valid, determining if the identifier is valid (recited "the access code is

then validated" as the MAC ID is determined to be valid, and " Valid PIN" as

determining if the identifier is valid; column 3, lines 49 – 55, FIG. 3, element 336 Valid

PIN(MAC)). It would have been obvious to one of ordinary skill in the art at the time the

invention was made to modify Schuster et al. and Fijolek et al. to include receiving an

identifier from the IP telephone; determining if a MAC ID for the IP telephone is valid; if

the MAC ID is determined to be valid, determining if the identifier is valid such as that

taught by Lee et al. in order to provide a method and apparatus for registering IP

phones with an IP phone switch using access codes or personal identification numbers

for authentication and for associating directory numbers to MAC address of IP phones

(as suggested by Lee et al., see column 1, lines 39 – 42).

Regarding claims 2, 17, 32, Schuster et al. disclose the limitation of the method,

system of claimed wherein said range of port numbers comprises ports which are not

reserved for use by other IP protocols (recited "request a set of locally unique ports from

router for external communications", "assigned thirty-two locally unique ports in the

range of 1026 – 1057" as operable to use at least a subset of the range of port numbers

to send or receive IP communications; column 11, lines 1 – 12; column 16, lines 13 –

20)

Regarding claims 3, 15, 18, 30, 33, 45, Schuster et al. disclose the limitation of

the method of claimed further comprising: mediating IP communications between the IP

telephone and an IP device, wherein the IP telephone uses at least a subset of the

range of port numbers to send or receive said IP communications (recited "request a set

of locally unique ports from router for external communications", "assigned thirty-two

locally unique ports in the range of 1026 – 1057" as operable to use at least a subset of

the range of port numbers to send or receive IP communications; column 11, lines 1 –

12; column 16, lines 13 – 20).

Regarding claims 4, 6, 19, 34, 21, 36, Schuster et al. disclose the limitation of the

method, system of claimed, wherein said mediating the IP communications comprises:

receiving a data packet from the IP telephone, performing a network address persistent

port translation (NAPPT) on the data packet (recited "Network Address Translation" as

network address persistent port translation (NAPPT) on the data packet, Fig. 9, column

15, lines 32 – 47); and sending the data packet to the IP device (recited "forwards the response data packets to network layer" as sending the data packet to the IP device; column 18, lines 30 – 33).

Regarding claims 5, 20, 35, Schuster et al. disclose the limitation of the method, system of claimed wherein the data packet comprises a private source IP address (recited "local IP address" as private source IP address; column 3, lines 2 – 3), a source port number (recited "locally unique port" as a source port number; column 3, lines 20 – 22), and destination information associated with the IP device (recited "a common external network address" as destination information associated with the IP device; column 3, lines 24 – 32), wherein the private source IP address comprises a private IP address of the IP telephone, and wherein the source port number comprises a port number in the assigned range of port numbers (column 3, lines 20 – 32; column 8, lines 45 – 50; column 10, lines 23 – 32; recited "request a set of locally unique ports from router for external communications", "assigned thirty-two locally unique ports in the range of 1026 – 1057" as operable to use at least a subset of the range of port numbers to send or receive IP communications; column 11, lines 1 – 12; column 16, lines 13 – 20); and wherein said performing a network address persistent port translation (NAPPT) on the data packet comprises changing the private source IP address to a public source IP address while leaving the source port number unchanged, and wherein the public source IP address and the source port number may be used to uniquely identify the IP telephone (Fig. 9, column 15, lines 32 – 47; column 16, lines 13 – 20).

Regarding claims 7, 22, 37, Schuster et al. disclose the limitation of the method,

system of claimed wherein the data packet comprises a public destination IP address, a

destination port number; and source information associated with the IP device, wherein

the destination port number comprises a port number in the assigned range of port

numbers, and wherein the public destination IP address and the destination port

number may be used to uniquely identify the IP telephone (column 3, lines 20 – 32;

column 8, lines 45 – 50; column 10, lines 23 – 32; column 16, lines 13 – 20); and

wherein said performing a network address persistent port translation (NAPPT) on the

data packet comprises using the public destination IP address and the destination port

number to uniquely identify the IP telephone, and changing the public destination IP

address to a private destination IP address while leaving the destination port number

unchanged, wherein the private IP address comprises an IP address of the IP telephone

(Fig. 9, column 15, lines 32 – 47; column 16, lines 13 – 20).

Regarding claim 16, Schuster et al. disclose the limitation of a system for

performing IP telephony, comprising: a network (recited "a network telephony system"

as a network; Fig. 1, column 5, line 16 – 24); an IP telephone (recited "network phones"

as IP telephone; Fig. 1, element 22, column 5, lines 24 – 26); a Service Gateway,

wherein the Service Gateway is operable to couple to the IP telephone through the

network (column 6, lines 23 – 25); wherein the IP telephone is operable to send an

identifier to the Service Gateway; wherein the Service Gateway is operable to: receive

an identifier from the IP telephone; determine if the identifier is valid; and if the identifier

is valid, assign a range of port numbers to the IP telephone based on the identifier;

wherein the IP telephone is operable to use at least a subset of the range of port

numbers to send or receive IP communications (column 8, lines 52 – 55; column 11,

lines 1 – 12, column 16, lines 13 – 20). Schuster et al. do not disclose explicitly

receiving an identifier from the IP telephone; determining if a MAC ID for the IP

telephone is valid; if the MAC ID is determined to be valid, determining if the identifier is

valid. Fijolek et al. disclose the limitation of determining if a MAC ID for the CM is valid;

if the MAC ID is determined to be valid (column 21, lines 12 – 30). However, Fijolek et

al. also do not disclose explicitly receiving an identifier from the IP telephone;

determining if a MAC ID for the IP telephone is valid; if the MAC ID is determined to be

valid, determining if the identifier is valid. Lee et al. disclose the limitation of receiving an

identifier from the IP telephone (recited "IP phone then sends a request for registration

to the IP phone service provider, which includes its MAC address and set type" as an

identifier from the IP telephone; column 3, lines 16 – 32, Fig. 3, element 318, Reg

Device (MAC, IP address, Set Type); determining if a MAC ID for the IP telephone is

valid (recited "upon receipt of the validation request" as determining if a MAC ID for the

IP telephone is valid; column 3, lines 44 – 45, Fig. 3, elements 334 Validate

PIN(MAC,PIN)); if the MAC ID is determined to be valid, determining if the identifier is

valid (recited "the access code is then validated" as the MAC ID is determined to be

valid, and " Valid PIN" as determining if the identifier is valid; column 3, lines 49 – 55,

FIG. 3, element 336 Valid PIN(MAC)). It would have been obvious to one of ordinary

skill in the art at the time the invention was made to modify Schuster et al. and Fijolek et

al. to include receiving an identifier from the IP telephone; determining if a MAC ID for

the IP telephone is valid; if the MAC ID is determined to be valid, determining if the identifier is valid such as that taught by Lee et al. in order to provide a method and apparatus for registering IP phones with an IP phone switch using access codes or personal identification numbers for authentication and for associating directory numbers to MAC address of IP phones (as suggested by Lee et al., see column 1, lines 39 – 42).

Regarding claims 8, 23, 38, Schuster et al. disclose the limitation of a method, system for configuring an IP telephone, comprising: receiving an identifier from the IP telephone (column 3, lines 20 – 32; column 8, lines 45 – 50; column 10, lines 23 – 32). Schuster et al. does not disclose expressly the method, system of claimed wherein the identifier comprises a vendor class identifier. Fijolek et al. disclose the limitation of the method, system of claimed wherein the identifier comprises a vendor class identifier (column 10, lines 60 – 67; column 11, lines 5 – 9; column 11 – 12, Table 1). It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Schuster et al. to include of the method, system of claimed wherein the identifier comprises a vendor class identifier such as that taught by Fijolek et al. in order to provide a variety of service offerings via and through a data-over-cable system, an exemplary data-over-cable system with telephony return includes customer premise equipment (e.g. a customer computer), a cable modem, a cable modem termination system, a cable television network, a public switched telephone network, a telephony remote access concentrator and a data network (e.g. the Internet). The cable modem termination system and the telephony remote access concentrator together are called a

·"telephony return termination system (as suggested by Fijolek et al., see column 5, lines

4 – 5; column 1, lines 65 – 67; column 2, lines 1 – 7).

Regarding claims 10, 25, 40, Schuster et al. disclose the limitation of a method,

system for configuring an IP telephone, comprising: receiving an identifier from the IP

telephone (column 3, lines 20 – 32; column 8, lines 45 – 50; column 10, lines 23 – 32).

Schuster et al. does not disclose explicitly the method, system of claimed wherein said

identifier is comprised in a DHCP discover message, the method further comprising:

issuing a DHCP offer to the IP telephone if the identifier is determined to be valid,

wherein the DHCP offer comprises DHCP lease information based on the validated

identifier; the IP telephone issuing a DHCP request in response to the issued DHCP

offer; storing the DHCP lease information in response to the issued DHCP request; the

IP telephone storing the DHCP lease information; and the IP telephone enabling DHCP

settings comprised in the DHCP lease information.  Fijolek et al. disclose the limitation

of the method, system of claimed wherein said identifier is comprised in a DHCP

discover message, the method further comprising: issuing a DHCP offer to the IP

telephone if the identifier is determined to be valid, wherein the DHCP offer comprises

DHCP lease information based on the validated identifier (Fig. 13, elements 270, 278,

280, 282, 286; column 25, lines 40 – 63); the IP telephone issuing a DHCP request in

response to the issued DHCP offer; storing the DHCP lease information in response to

the issued DHCP request; the IP telephone storing the DHCP lease information; and the

IP telephone enabling DHCP settings comprised in the DHCP lease information (Fig.

13, elements 300, 302, 308, 312, 318, 322, 320, 324; column 25, lines 40 – 63; column

26, lines 44 – 64). It would have been obvious to one of ordinary skill in the art at the

time the invention was made to modify Schuster et al. to include of the method, system

of claimed wherein said identifier is comprised in a DHCP discover message, the

method further comprising: issuing a DHCP offer to the IP telephone if the identifier is

determined to be valid, wherein the DHCP offer comprises DHCP lease information

based on the validated identifier; the IP telephone issuing a DHCP request in response

to the issued DHCP offer; storing the DHCP lease information in response to the issued

DHCP request; the IP telephone storing the DHCP lease information; and the IP

telephone enabling DHCP settings comprised in the DHCP lease information as that

taught Fijolek et al. in order to provide a variety of service offerings via and through a

data-over-cable system, an exemplary data-over-cable system with telephony return

includes customer premise equipment (e.g. a customer computer), a cable modem, a

cable modem termination system, a cable television network, a public switched

telephone network, a telephony remote access concentrator and a data network (e.g.

the Internet). The cable modem termination system and the telephony remote access

concentrator together are called a "telephony return termination system (as suggested

by Fijolek et al., see column 5, lines 4 – 5; column 1, lines 65 – 67; column 2, lines 1 –

7).

    Regarding claims 11, 12, 26, 27, 41, 42, Schuster et al. disclose the limitation of

the method, system of claimed, wherein the range of port numbers and information

indicating operational software for the IP telephone (column 5, lines 55 – 67; column 13,

lines 14 – 21; column 16, lines 13 – 20), the method further comprising: the IP

telephone executing the indicated operational software to enable said IP

communications (column 13, lines 14 – 21; column 16, lines 13 – 20; column 6, lines 3 –

23). Schuster et al. do not disclose expressly the method, system of claimed wherein

said DHCP lease information. Fijolek et al. disclose the limitation of the method, system

of claimed wherein said DHCP lease information (column 24, lines 40 – 67). It would

have been obvious to one of ordinary skill in the art at the time the invention was made

to modify Schuster et al. to include of the method, system of claimed wherein said

DHCP lease information such as that taught by Fijolek et al. in order to provide a variety

of service offerings via and through a data-over-cable system, an exemplary data-over-

cable system with telephony return includes customer premise equipment (e.g. a

customer computer), a cable modem, a cable modem termination system, a cable

television network, a public switched telephone network, a telephony remote access

concentrator and a data network (e.g. the Internet). The cable modem termination

system and the telephony remote access concentrator together are called a "telephony

return termination system (as suggested by Fijolek et al., see column 5, lines 4 – 5;

column 1, lines 65 – 67; column 2, lines 1 – 7).

Regarding claims 13, 28, 43, Schuster et al. disclose the limitation of a method,

system for configuring an IP telephone, comprising: receiving an identifier from the IP

telephone (column 3, lines 20 – 32; column 8, lines 45 – 50; column 10, lines 23 – 32).

Schuster et al. do not disclose explicitly the method of claimed wherein said issuing the

request for the operational software comprises issuing a read request to a file transfer

server, wherein said file transfer server performs said providing the operational software

to the IP telephone.  Fijolek et al. disclose the limitation of  the method of claimed

wherein said issuing the request for the operational software comprises issuing a read

request to a file transfer server, wherein said file transfer server performs said providing

the operational software to the IP telephone (receives a configuration file from a

configuration filer server" as transfer server performs said providing the operational

software to the IP telephone; column 9, lines 32 – 35; column 25, lines 65 – 67; column

26, lines 1 – 13).  It would have been obvious to one of ordinary skill in the art at the

time the invention was made to modify Schuster et al. to include the method of claimed

wherein said issuing the request for the operational software comprises issuing a read

request to a file transfer server, wherein said file transfer server performs said providing

the operational software to the IP telephone such as that taught Fijolek et al. in order to

provide a variety of service offerings via and through a data-over-cable system, an

exemplary data-over-cable system with telephony return includes customer premise

equipment (e.g. a customer computer), a cable modem, a cable modem termination

system, a cable television network, a public switched telephone network, a telephony

remote access concentrator and a data network (e.g. the Internet). The cable modem

termination system and the telephony remote access concentrator together are called a

"telephony return termination system (as suggested by Fijolek et al., see column 5, lines

4 – 5; column 1, lines 65 – 67; column 2, lines 1 – 7).

Regarding claims 14, 29, 44, Schuster et al. discloses the limitation of a method,

system for configuring an IP telephone, comprising: receiving an identifier from the IP

telephone (column 3, lines 20 – 32; column 8, lines 45 – 50; column 10, lines 23 – 32).

Schuster et al. do not disclose explicitly the method, system of claimed wherein the file

transfer server comprises a TFTP (Trivial File Transfer Protocol) server. Fijolek et al.

disclose the limitation of the method, system of claimed wherein the file transfer server

comprises a TFTP (Trivial File Transfer Protocol) server (recited "TFTP layer" as a

TFTP (Trivial File Transfer Protocol) server; column 9, lines 32 – 35; column 25, lines

65 – 67; column 26, lines 1 – 13). It would have been obvious to one of ordinary skill in

the art at the time the invention was made to modify Schuster et al. to include of the

method, system of claimed wherein the file transfer server comprises a TFTP (Trivial

File Transfer Protocol) server such as that taught by Fijolek et al. in order to provide a

variety of service offerings via and through a data-over-cable system, an exemplary

data-over-cable system with telephony return includes customer premise equipment

(e.g. a customer computer), a cable modem, a cable modem termination system, a

cable television network, a public switched telephone network, a telephony remote

access concentrator and a data network (e.g. the Internet). The cable modem

termination system and the telephony remote access concentrator together are called a

"telephony return termination system (as suggested by Fijolek et al., see column 5, lines

4 – 5; column 1, lines 65 – 67; column 2, lines 1 – 7). Reference Lee et al. also teach

TFTP server (Fig. 2, element 304 TFTP Server).


## Response to Arguments

6.  Applicant's arguments filed 05/12/2006 with respect to claims 1 – 8, 10 – 23, 25 –

38, 40 – 45 have been fully considered but they are not persuasive.

Applicant argues the references Fijolek et al. and Lee et al. do not teach the
limitation of determining if a MAC ID for the IP phone is valid; if the MAC ID is
determined to be valid, determining if the identifier is valid. Examiner contends
references Fijolek et al. disclose determining if a MAC ID for the IP phone is valid; if the
MAC ID is determined to be valid, determining if the identifier is valid (see column 21,
lines 12 – 30, lines 50 – 55; column 24, lines 49 – 49 – 60). Lee et al. teach determining
if a MAC ID for the IP phone is valid; if the MAC ID is determined to be valid,
determining if the identifier is valid (see column 1, lines 39 – 42).

### *Conclusion*

7.  The prior art made of record and not relied upon is considered pertinent to
applicant's disclosure.

- Xu et al. (US 6738362) teach mobile internet protocol (IP) networking with
  home agent and/or foreign agent functions distributed among multiple
  devices

- Kung et al. (US 6775273) teach simplified IP service control and service
  control based on multiple relationships between equipment specific unique
  media access control (MAC) addresses, system addresses and directory
  numbers to enable the properly route traffic between the broadband
  communication system and legacy telephone systems.

- Mahler et al. (US 6381638) disclose system and method for options based address reuse anda combination network address for identifying the host device to the server device.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Andrew C. Lee whose telephone number is (571) 272-3131. The examiner can normally be reached on Monday through Friday from 8:30am - 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ricky Ngo can be reached on (571) 272-3139. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/ACL/                          Dec 10, 2006

WING CHAN
SUPERVISORY PATENT EXAMINER